

REMARKS

1. Specification Objection - Title

The Examiner objected to the title as not descriptive. Applicants have herein proposed a new title of "Method And Server Apparatus For Automatically Preparing Tax Forms For Gaming Winnings." Applicants submit that the new title has addressed the Examiner's concerns. Applicants respectfully submit that the objection to the title has been overcome.

2. Claims Objections - Claims 16 and 17

Claims 16 and 17 were objected to for indicating that they were amended in the previous Office Action response, but not showing any actual amendment. Claims 16 and 17 have been reproduced below as they appeared in the previous amendment of November 12, 2003 for the Examiner's convenience. Please note the added colon (":"), after the word comprising, at the end of the first line of both claims 16 and 17.

16. (Currently amended) The network of claim 15, further comprising:  
a networking computer connected to a plurality of gaming machines and the central control unit, the networking computer facilitating electronic communication between the plurality of gaming machines and the central control unit.

17. (Currently amended) The network of claim 15, further comprising:  
a player card encoder, wherein each of the at least one gaming machines is in electronic communication with a card reader capable of reading information encoded on a player card.

Applicants assume that the minor punctuation amendments of the previous Office Action response were inadvertently overlooked by the Examiner. Applicants submit that the claim objection to claims 16 and 17 should be withdrawn.

3. Claims Rejections - 35 U.S.C. §102(e) - Claims 11-19, 22-25, 27-33, 35-44, and 47

Claims 11-19, 22-25, 27-33, 35-44, and 47 were rejected in the Office Action dated January 30, 2004, under 35 U.S.C. §102(e) as being anticipated by Acres (U.S. Patent No. 6,312,333). Applicants respectfully traverse this rejection. However, in order to provide

clarification only, claims 11, 23, 24, 29, and 36 have been amended. Claims 11, 23, 24, 29, and 36 are independent claims. Claims 12-19 and 22 depend from independent claim 11; claims 25 and 27-28 depend from independent claim 24; claims 30-33 and 35 depend from independent claim 29; and claims 37-44 and 47 depend from independent claim 36. For brevity, only the bases for the rejection of the independent claims are traversed in detail on the understanding that the dependent claims are also patentably distinct over the prior art as they depend directly from their respective independent claim. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

The Examiner has taken the position that the Acres patent anticipates the invention of claims 11-19, 22-25, 27-33, 35-44, and 47 (i.e., includes each and every element of claims 11-19, 22-25, 27-33, 35-44, and 47). The claimed invention, as amended, (1) “enables pay-out to the player of all winnings, including all winnings over the threshold amount during the reduced interruption gaming session,” and further, (2) “the pay-out occurs before a jackpot-related information statement is generated.”

In contrast, the Acres patent discloses a gaming machine that accepts bets from a player and provides a payout in response to a winning bet that is under a payout threshold amount. Importantly, the Acres patent (1) intentionally locks-up the gaming machine if the payout is over a pre-established threshold, (2) performs a calculation based upon the amount of payout over the pre-established threshold, and (3) reduces the amount of the payout over the threshold (i.e., it withholds a percentage of the winnings over the threshold amount for taxes), before unlocking the gaming machine after the reduced payout has been authorized. Again, the Acres gaming machine *actually reduces the amount of the payout over a specified threshold by withholding a percentage of the winnings over the threshold amount for tax payment*. Thus, the Acres gaming machine does NOT enable pay-out to the player of all winnings, including all winnings over the threshold amount during the reduced interruption gaming session, as required by the claimed invention. Indeed, the Acres gaming machine NEVER pays-out all winnings over the threshold amount during the reduced interruption gaming session since the Acres gaming machine *actually decreases the*

*winnings over the threshold amount to enforce taxation of winnings before they even reach the player's hands.* Furthermore, this immediate taxation enforcement of winnings over a threshold amount is an action that many patrons may find highly objectionable and annoying.

Additionally, the Examiner has stated that in cases where the player already has the necessary information on file, the Acres patent will "immediately approve the award and make payment," and thus, no delay is encountered. The Examiner has quoted from Acres, Col. 6, line 50, as support for his position that no delay is encountered with the Acres gaming machine. However, the Examiner has not mentioned the preceding sentence that states: "Once the amount to be paid is determined, the casino can program the system, in accordance with IRS requirements, to take one of several actions." (Emphasis added). Accordingly, as Col. 6, lines 13-46 of the Acres patent are examined, it becomes clear that Acres (1) *intentionally locks-up the gaming machine* if the payout is over a pre-established threshold, (2) performs a calculation based upon the amount of payout over the pre-established threshold, and (3) reduces the amount of the payout over the threshold, before unlocking the gaming machine after the reduced payout has been authorized. Only after these events occur, can the Acres patent "approve the award and make payment." Thus, the Acres gaming machine NEVER pays-out all winnings over the threshold amount. Accordingly, only a portion of the award over the pre-established threshold is paid out, and even that reduced payment is far from immediate.

In conclusion, the Acres patent does not teach or suggest each and every element of the claimed invention, and is in fact incongruous with the claimed invention. Acres patent discloses a system that is directly at odds with the claimed invention, and accordingly, actually teaches away from the claimed invention. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 102(e) rejection of claims 11-19, 22-25, 27-33, 35-44, and 47 as unpatentable over Acres has been overcome.

4. Claims Rejections - 35 U.S.C. §103(a) – Claims 1, 2, and 4-10

Claims 1, 2, and 4-10 were rejected in the Office Action dated January 30, 2004, under 35 U.S.C. § 103(a) as being anticipated by Bell et al. (U.S. Patent No. 5,505,461). Applicants

respectfully traverse this rejection. However, in order to provide clarification only, claim 1 has been amended. Claim 1 is an independent claim. Claims 2 and 4-10 depend from independent claim 1. The basis for the rejection of the independent claim is traversed in detail on the understanding that dependent claims are also patentably distinct over the prior art as they depend directly from independent claim 1. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

The Examiner has taken the position that the Bell patent anticipates the invention of claims 1, 2, and 4-10 (i.e., includes each and every element of claims 1, 2, and 4-10). The claimed invention, as amended, requires (1) ensuring that the player continuously maintains access to all winnings, including all winnings over the threshold amount; and (2) enabling pay-out to the player of all winnings, including all winnings over the threshold amount during the reduced interruption gaming session, wherein the pay-out occurs before a jackpot-related information statement is generated.

In contrast, the Bell patent discloses a gaming machine that does NOT provide a payout in response to a winning bet that is over the payout threshold amount, but rather transfers this non-received payout into a credit on an IRS reportable credit meter where the non-received payout is stored. Accordingly, the Bell patent does NOT "enable pay-out to the player of all winnings, including all winnings over the threshold amount during the reduced interruption gaming session," as required by the claimed invention. Instead, the Bell patent prevents the payout of this credit until after a tax form has been produced. Thus, the Bell gaming machine does NOT ensure that the player continuously maintains full access to any winnings over the threshold amount, as required by the claimed invention. In fact, claim 1 of the Bell patent includes the claim element "means for preventing payout of said credit in said IRS credit storage means by said player." Thus, the Bell patent teaches directly away from the claimed invention. Furthermore, the claimed invention also recites that the IRS reporting statement (i.e., statement referencing the recorded jackpot-related information and stored player-related information) be generated after the reduced interruption gaming session is terminated. The Bell patent requires just the opposite, that the gaming session

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must be ended and the IRS reporting statement generated (either printed or filled out by an attendant) before the player can be cashed out.

In conclusion, the Bell patent does not teach or suggest each and every element of the claimed invention, and is in fact incongruous with the claimed invention. Indeed the Bell patent, while dealing with related issues, discloses a system that is directly at odds with the claimed invention, and thus, actually teaches away from the claimed invention. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 102(b) rejection of claims 1, 2, and 4-10 as unpatentable over Bell has been overcome.

5. Claims Rejections - 35 U.S.C. §103(a) – Claim 3

Claim 3 was rejected in the Office Action dated January 30, 2004, under 35 U.S.C. § 103(a) as being unpatentable in view of Bell et al., and further in view of Bergeron et al. (U.S. Patent No. 4,882,473) and Pease et al. (U.S. Patent No. 5,326,104). Applicants respectfully traverse this rejection. However, in order to provide clarification only, claims 1 and 3 have been amended. Claim 1 is an independent claim. Claim 3 depends from independent claim 1. For brevity, only the bases for the rejection of the independent claim 1 are traversed in detail on the understanding that dependent claim 3 is also patentably distinct over the prior art as it depends directly from independent claim 1. Nevertheless, the dependent claim 3 includes additional features that, in combination with those of independent claim 1, provide further, separate, and independent bases for patentability.

The Examiner states that the Bell patent teaches the invention substantially as claimed, but does not teach inserting an agent card or selecting uninterrupted play from a menu. The Examiner further states that Bergeron teaches insertion of an agent card for the purpose of enhancing security, and that Pease teaches a menu-driven system. The shortcomings of the Bell patent are well documented in Section 4 above. Neither the Bergeron patent nor the Pease patent satisfy these shortcomings.

The Bell, Bergeron, and Pease patents do not teach or suggest each and every element of the claimed invention. Indeed the Bell patent, while dealing with related issues, discloses a

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system that is directly at odds with the claimed invention, and thus, actually teaches away from the claimed invention. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 3 as unpatentable has been overcome.

6. Claims Rejections - 35 U.S.C. §103(a) – Claims 20, 21, 26, 34, 45, and 46

Claims 20, 21, 26, 34, 45, 46, and 48-50 were rejected in the Office Action dated January 30, 2004, under 35 U.S.C. § 103(a) as being unpatentable in view of Acres (U.S. Patent No. 6,312,333), and further in view of Bergeron et al. (U.S. Patent No. 4,882,473) and Pease et al. (U.S. Patent No. 5,326,104). Applicants respectfully traverse this rejection. However, in order to provide clarification only, claims 20, 21, 26, 34, 45, and 46 have been amended. Claims 48-50 have been canceled. Claims 11, 23, 24, 29, and 36 are independent claims. Claims 20 and 21 depend from independent claim 11; claim 26 depends from independent claim 24; claim 34 depends from independent claim 29; and claims 45 and 46 depend from independent claim 36. For brevity, only the bases for the rejection of the independent claims are traversed in detail on the understanding that dependent claims are also patentably distinct over the prior art as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

The Examiner states that the Acres patent teaches the invention substantially as claimed, but does not teach inserting an agent card or selecting uninterrupted play from a menu. The Examiner further states that Bergeron teaches insertion of an agent card for the purpose of enhancing security, and that Pease teaches a menu-driven system. The shortcomings of the Acres patent are well documented in Section 3 above. Neither the Bergeron patent nor the Pease patent satisfy these shortcomings.

In conclusion, the Acres, Bergeron, and Pease patents do not teach or suggest each and every element of the claimed invention. The Acres patent discloses a system that is directly at odds with the claimed invention, and accordingly, actually teaches away from the claimed

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invention. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claims 20, 21, 26, 34, 45, and 46 as unpatentable has been overcome.

7. Telephonic Interview

Applicant's representative and the Examiner conducted a telephonic interview on May 24, 2004, regarding the outstanding Office Action. During this telephonic interview the Applicant's representative proposed amendments that were intended to clarify the differences between the claimed invention and the prior art, and show that the claimed invention is patentably distinct over the prior art. Specifically, the Applicant's representative pointed out that in the claimed invention of the present application, the player is able to cash out on winnings over the threshold amount during the reduced interruption gaming session and before a reporting statement is generated; thus, "*ensuring that the player continuously maintains access to all winnings, including all winnings over the threshold amount,*" as required in the claimed invention, as amended. In contrast, the cited references do not allow a player to have continuous access to all winnings, including all winnings over the threshold amount, but rather prevent winnings over the threshold amount from being paid out until after the gaming session is ended and the reporting statement is generated. Indeed, the Acres patent NEVER pays out all winnings over the threshold amount since the Acres patent withholds a portion of the winnings over the threshold amount (which are debited for taxes) before these winnings are ever seen by the player. The claimed invention does no such debiting. It simply provides for reduced interruption gaming sessions by generating a jackpot-related information statement after the reduced interruption gaming session has ended.

Applicant's representative also explained that the claimed invention, in a preferred embodiment, is a central server that is connectable to one or more gaming machines, but is not a gaming machine itself. The Examiner stated that he found this distinction confusing. The Examiner requested that the Applicant's representative file a formal amendment and response that detailed the above distinctions. The Examiner also indicated that a further search might be necessary.

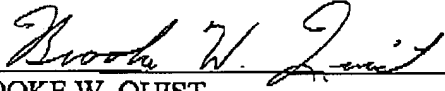
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CONCLUSION

Applicant has made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is clear that the differences between the claimed invention and the prior art are such that the claimed invention is patentably distinct over the prior art. Therefore, reconsideration and allowance of claims 1-47 is believed to be in order, and an early Notice of Allowance to this effect is respectfully requested. If the Examiner should have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8319. The undersigned attorney can normally be reached Monday through Friday from about 9:30 AM to 6:30 PM Pacific Time.

Respectfully submitted,

Dated: 6/1/04

  
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